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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/807,143	04/06/2001	Kenichi Mitsui	33483	3204

116 7590 05/02/2006

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EXAMINER	
RAMAKRISHNAIAH, MELUR	

ART UNIT	PAPER NUMBER
2614	

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/807,143	**Applicant(s)** MITSUI ET AL.	
	Examiner Melur Ramakrishnaiah	**Art Unit** 2614	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 23 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Attached Explanation.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 2-21-06
13. ☐ Other: _____.

Melur Ramakrishnaiah
Primary Examiner
Art Unit: 2614

Response to Arguments after Final Rejection

Rejection of Claims 1-5 and 12-13 under 35 U.S.C 103(a) as being obvious over Irube (US PAT: 6,377,818) in view of Parulski et al. (US PAT: 5,900,909, hereinafter Parulski): Regarding rejection of the claims, Applicant argues that "there is no suggestion or motivation for one skilled in the art at the time invention was made to combine Parulski with Irube to arrive at the claimed invention. The mere fact that references can be combined does not render the resultant combination obvious unless prior art suggests the desirability of the combination". In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as set forth in the final rejection, Irube differs from the claimed invention in not specifically teaching detecting means for detecting an orientation of the video telephone apparatus and rotating means for rotating the orientation of the image in at least either of the transmit picture signal and the received picture signal based on the detected orientation of the video telephone apparatus and independent of the orientation of a distant party video telephone apparatus. However, Parulski teaches an electronic device, i.e., a camera, having a orientation sensor (40, figure 2), read as detector means, for detecting the orientation of

the electronic device (col. 3 lines 63-65) and a processor (22, figure 2), read as rotating means, for rotating the orientation of an image based on the detected orientation of the electronic device, which is independent of the orientation of a distant party video telephone apparatus (col. 3 line 60 through col. 5 line 4), in order to ensure that the image is correctly displayed on screen without use of special application program. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify Irube in having detecting means for detecting the orientation of the video telephone apparatus and rotating means for rotating the orientation of the image in at least either of the transmit picture signal and the received picture signal based on the detected orientation of the video telephone apparatus and independent of the orientation of a distant party video telephone apparatus, as per teaching of Parulski, in order to ensure that the image is correctly displayed on screen without use of special application program.

Applicant further refers to page 9 lines 14-20, lines 4-7 of final rejection and argues that "Irube already teaches a solution of processing an image to be displayed, so the image can be displayed correctly regardless of the holding direction of the video telephones. Since Irube already solves the problem of displaying the image ... Therefore, the office action made no showing of a suggestion or motivation in Irube or Parulski to make the proposed combination in Irube. The desirability of such a modification is found only in Applicant's own description of the invention, in contrast to requirement that the teaching or suggestion to make the modification must be found in the prior art, and not found on an Applicant's disclosure". Regarding this, it appears that

applicant is making hindsight argument in response to the combination of references. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In light of the above explanation, rejection of claims 1-14 is maintained.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614